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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,088	03/18/2004	Tsukasa Kosuda	SE-US035173	5318
22919 7590 05/28/2008 GLOBAL IP COUNSELORS, LLP 1233 20TH STREET, NW, SUITE 700 WASHINGTON, DC 20036-2680			EXAMINER NATNITHITHADHA, NAVIN	
			ART UNIT 3735	PAPER NUMBER
			MAIL DATE 05/28/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/803,088

**Applicant(s)**

KOSUDA ET AL.

**Examiner**

NAVIN NATNITHITHADHA

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**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6, 11, and 13-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 11 and 13-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/808)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12 May 2008 has been entered.

### ***Response to Amendment***

2. The status of the claims is as follows:
- Claims 1-6, 11, 13-17, and 20 are currently amended;
- Claims 18 and 19 are as originally filed;
- Claims 24 and 25 are added; and
- Claims 7-10, 12, and 20-23 are cancelled.

### ***Response to Arguments***

3. Applicant's arguments, see Remarks, pp. 8-9, filed 12 May 2008, with respect to the rejection of claims 1-6, 11, and 13-20 under 35 U.S.C. 103(a) as being unpatentable over Raymond et al, U.S. Patent No. 6,282,441 B1 ("Raymond"), in view of Odagiri et al,

U.S. Patent No. 5,749,366 A ("Odagiri"), have been fully considered, but they are not persuasive.

Applicant contends, see Remarks, pp. 8-9, that "[the] prior art of record discloses detecting motions, but none of the prior art of record discloses that the motion detector detects the changes in the shape of the mounting area... [and] that this arrangement is not disclosed or suggested by Raymond, Odagiri, or any other prior art of record". However, this argument is not persuasive. Raymond does, in fact, teach a motion detector 132 that detects the changes in the shape, i.e. circumferential expansion and contraction, of the mounting area, i.e. chest (see figs. 2 and 2A, and col. 6, ll. 47-50).

#### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1-6, 11, 13-20, 24, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Raymond et al, U.S. Patent No. 6,282,441 B1 ("Raymond"), in view of Odagiri et al, U.S. Patent No. 5,749,366 A ("Odagiri").

Claims 1-6, 11, and 13-20: Raymond teaches an information-gathering device ("health tracking system") 100 being configured to gather information relating to a pulse (see figs. 2, 2A, and 3, and col. 5) comprising:

a sensor module ("multiparametric physiological monitor") 108 being configured to be mounted to a mounting area on a body of a user ("chest"); and

a supporter ("chest strap") 124 being configured to mount said sensor module 108;

said sensor module 108 including:

a first motion detector ("chest expansion sensor") 132, e.g. a displacement sensor ("tension sensing device," see col. 7, ll. 46-47), being configured to detect changes in the shape of said mounting area, and to output a motion detection signal based on said changes (see figs. 2 and 2A, and col. 6, ll. 47-50);

a second motion detector, e.g. acceleration sensor ("accelerometer") 134, being configured to detect motion components generated along with body movement, and to output a second motion detection signal;

a pulse wave detector/sensor ("EKG electrodes") 140 being configured to detect pulse wave components corresponding to a pulsating flow in said body, and to output a pulse wave detection signal ("EKG signal pulse," see col. 15, ll. 54-67), wherein the motion detector 132 is adjacent to and on the same side of the mounting area with respect to the pulse wave detector 140 (see fig. 2);

a transmitter ("modem") 110;

a power generation device ("batteries," not labeled, see col. 5, ll. 18-19);

a processor ("monitor hardware") 144.

Raymond does not teach "a removal processor being configured to remove motion components denoting said changes from said pulse wave detection components" (claim 1) or "a removal processor being configured to remove motion components denoting said changes by using said second motion detection signal when

said second motion detector detects said motion components, and to remove motion components by using said first motion detection signal when said second motion detector does not detect said motion components" (claim 11). However, a removal processor that removes motion components from pulse wave signals is well known in the art. For example, Odagiri teaches an information-gathering device being configured to gather information relating to a pulse ("a motion compensating pulse rate monitor with motion sensor", see Abstract), comprising: a pulse wave detector ("pulse detecting means") 106; a motion detector ("motion detecting means") 101; and a removal processor ("CPU") 1104 configured to remove motion components denoting said changes from a pulse wave detection signal (see Abstract, col. 1, ll. 6-10, and col. 8, ll. 30-37). Thus, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify Raymond's processor 144 to remove motion components from a pulse wave detection signal as taught by Odagiri because "the user can obtain the pulse data continuously at predetermined time intervals without being conscious about the measuring environment", as stated by Odagiri, col. 8, ll. 30-37.

Claims 24 and 25: The limitations "wherein said mounting area is a wrist of said body, and said changes are in thickness of said wrist", and "wherein said changes are made when said user clenches or unclenches" (claim 1 recites "a sensor module being configured to be mounted to a mounting area on a body of a user") are recitations of the intended use of the claimed invention. Using such language is a recitation of the intended use of the claimed invention, which must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the

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claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). Although Raymond's sensor module ("multiparametric physiological monitor") 108 is used to monitor chest expansion and contraction in the "preferred embodiment", Raymond explicitly states that the sensor module 108 is "mounted by a strap about a part of the body other than the chest" (see col. 6, ll. 6-26), and thus, sensor module 108 is capable of mounting on a wrist and monitoring the changes of the wrist circumference.

***Conclusion***

5. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **NAVIN NATNITHITHADHA** whose telephone number is (571)272-4732. The examiner can normally be reached on Monday-Friday, 9:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor, II can be reached on (571) 272-4730. The fax phone



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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Charles A. Marmor, II/  
Supervisory Patent Examiner  
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/N. N./  
Patent Examiner, Art Unit 3735  
05/27/2008